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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,307	03/22/2004	Fumiharu Nakayama	016907-1632	9166
22428 7590 10/26/2009 FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			EXAMINER RODRIGUEZ, LENNIN R	
			ART UNIT 2625	PAPER NUMBER
			MAIL DATE 10/26/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/805,307

Applicant(s)

NAKAYAMA, FUMIHARU

Examiner

LENNIN R. RODRIGUEZ

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 13-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 13-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on 7/2/2009 have been fully considered but they are not persuasive. Applicant's argument regarding "None of the cited art of record teaches or suggests that an uppermost part of the two antennas is provided at a position higher than a position that is lower by a predetermined distance than the uppermost part of the reversing automatic document feeder" has been fully considered; in response Nakamura '854 discloses wherein an uppermost part of the antenna is provided at a position higher than a position that is lower by a predetermined distance than an uppermost part of the reversing automatic document feeder (Drawing 2, where by virtue of the drawing the antenna is provided at a position higher than for example ground 91 (being used as the predetermined position lower than the top of the automatic feeder)).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 17 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed,

had possession of the claimed invention. The limitation "wherein the uppermost part of the two antennas is provided at a position between the uppermost part of the reversing automatic document feeder and a position that is lower by the predetermined distance than the uppermost part of the reversing automatic document feeder" discloses a situation which was not described by the original claims and was not described in the specifications anywhere before this instance, therefore the claims raise new matter.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 1-3 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura (JP 2002-086854, all citations from the machine translation) in view of Lueker (US 6,134,105), Tamagaki et al. (US 6,040,924) and Talwar (US 5,117,505).

(1) regarding claim 1:

Nakamura '854 discloses an image forming apparatus (1 in Fig. 1) comprising:

a main body of the image forming apparatus (It is evident in Fig. 1 that the printing apparatus has a body);

a wireless LAN module that is provided inside a rear surface of the main body of the image forming apparatus (Abstract, SOLUTION, lines 3-7, paragraph [0014], lines 1-2 and 112, in Fig. 1, where the control circuit contains the wireless LAN and is located at the back of the printer as could be referenced by looking at Fig 1 and looking at the

control panel 113, generally at the front of a printer so users can have easy access to it);

an antenna that is provided on the rear surface of the main body of the image forming apparatus (111 in Fig. 1, where the antenna is located on the back of the printer if you are looking at it from the right side of the figure where the control panel 113 is); and

a cable that connects the wireless LAN module and the antenna with a shortest distance (as can be shown in Fig. 1, antenna 111 and control circuit 112 are close together, it is inherent that a cable should be use for connecting an antenna with something else, in this case a wireless LAN, since an antenna by itself does not performs any functionality and by looking at the closeness of the two components it is apparent for the examiner that the shortest distance of cable should be used, because it would be unnecessary the use of extra cable for such a short connection), and

wherein an uppermost part of the antenna is provided at a position higher than a position that is lower by a predetermined distance than an uppermost part of the reversing automatic document feeder (Drawing 2, where by virtue of the drawing the antenna is provided at a position higher than for example ground 91 (being used as the predetermined position lower than the top of the automatic feeder)).

Nakamura '854 discloses all the subject matter as described above except for the image forming apparatus having two antennas.

However, Lueker '105 teaches the image forming apparatus having two antennas (21 in Fig. 1 and column 3, line 65 through column 4, line 1, where the printer has three antennas attached (two included) for data communication).

Having a system of Nakamura '854 reference and then given the well-established teaching of Lueker '105 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the image forming apparatus of Nakamura '854 to include the image forming apparatus having two antennas as taught by Lueker '105 because it would be desirable to have available a single, easily transported command unit which provides a fully functional, easily deployed and immediately operable communications and information transfer capability to users in remote locations. This command center would replicate and provide the functionality of a home agency information and computing system to a user at a remote site (column 1, lines 57-63).

Nakamura '854 and Lueker '105 disclose all the subject matter as described above except a reversing automatic document feeder that is provided on an upper part of the main body of the image forming apparatus;

However, Tamagaki '924 teaches a reversing automatic document feeder (3 in Fig. 1) that is provided on an upper part of the main body of the image forming apparatus (as can be seen from Fig. 1 the feeder is in the upper part of the main body 1);

Having a system of Nakamura '854 and Lueker '105 and then given the well-established teaching of Tamagaki '924 reference, it would have been obvious to one

having ordinary skill in the art at the time the invention was made to modify the image forming apparatus of Nakamura '854 and Lueker '105 to include a reversing automatic document feeder that is provided on an upper part of the main body of the image forming apparatus as taught by Tamagaki '924 because with this automatic feeder the scanning of documents becomes easier and faster than doing it manually, one by one, and also giving the advantage of double side scanning, thus making it user-friendlier.

Nakamura '854, Lueker '105 and Tamagaki '924 disclose all the subject matter as described above except wherein the two antennas are disposed at positions where a first of the two antennas compensates for degradation in radiation characteristics of a second of the two antennas caused by the reversing automatic document feeder.

However, Talwar '505 teaches wherein the two antennas are disposed at positions where a first of the two antennas compensates for degradation in radiation characteristics of a second of the two antennas caused by an apparatus (column 11, lines 40-50, where by comparison of signals of each antenna the interference signal is calculated and cancelled, even though in this case it is not specifically an automatic feeder, it would be apparent for a person of ordinary skill in the art that the noise cancellation for any apparatus, would work the same way with an automatic feeder).

Having a system of Nakamura '854, Lueker '105 and Tamagaki '924 and then given the well-established teaching of Talwar '505 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the image forming apparatus of Nakamura '854, Lueker '105 and Tamagaki '924 to include wherein the two antennas are disposed at positions where a first of the two

antennas compensates for degradation in radiation characteristics of a second of the two antennas caused by an apparatus as taught by Talwar '505 because it would be desirable to have an interference cancellation system which will minimize noise degradation of a receiver (column 3, lines 38-42).

(2) regarding claim 2:

Nakamura '854 further discloses wherein the wireless LAN module is provided on a control board that is disposed inside the rear surface of the main body of the image forming apparatus (Abstract, SOLUTION, lines 3-7, paragraph [0014], lines 1-2 and 112, in Fig. 1, where the control circuit contains the wireless LAN and is located at the back of the printer as could be referenced by looking at Fig 1 and looking at the control panel 113, generally at the front of a printer so users can have easy access to it).

(3) regarding claim 13:

Nakamura '854 further discloses wherein the rear surface of the main body is perpendicular to a ground surface upon which the image forming apparatus sits (111 in Drawing 2, as can be seen by the position of the antenna and the back face 110 of printer 1, it is clearly perpendicular to surface 91).

(4) regarding claim 3:

Nakamura '854, Lueker '105 and Tamagaki '924 disclose all the subject matter as described above except wherein the two antennas respectively comprise a main antenna and a sub-antenna.

However, Talwar '505 teaches wherein the two antennas respectively comprise a main antenna (60 in Fig. 2) and a sub-antenna (66 in Fig. 2).

Having a system of Nakamura '854, Lueker '105 and Tamagaki '924 and then given the well-established teaching of Talwar '505 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the image forming apparatus of Nakamura '854, Lueker '105 and Tamagaki '924 to include wherein the two antennas respectively comprise a main antenna and a sub-antenna as taught by Talwar '505 because it would be desirable to have an interference cancellation system which will minimize noise degradation of a receiver (column 3, lines 38-42).

(5) regarding claim 14:

Nakamura '854, Lueker '105 and Tamagaki '924 disclose all the subject matter as described above except wherein the radiation characteristics are horizontal radiation characteristics.

However, Talwar '505 teaches wherein the radiation characteristics are horizontal radiation characteristics (as it is apparent in the drawings, Figs. 2-6, the two antennas are situated at the same level, thus picking up the signals at the same level, being interpreted as horizontal).

Having a system of Nakamura '854, Lueker '105 and Tamagaki '924 and then given the well-established teaching of Talwar '505 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the image forming apparatus of Nakamura '854, Lueker '105 and Tamagaki '924 to include wherein the radiation characteristics are horizontal radiation characteristics as taught by Talwar '505 because it would be desirable to have an interference

cancellation system which will minimize noise degradation of a receiver (column 3, lines 38-42).

(6) regarding claim 15:

Nakamura '854, Lueker '105 and Tamagaki '924 disclose all the subject matter as described above except wherein the two antennas are respectively arranged on left and right sides of the rear surface of the main body of the image forming apparatus.

However, Talwar '505 teaches wherein the two antennas are respectively arranged on left and right sides of the rear surface of the main body of the image forming apparatus (as it is apparent in the drawings, Figs. 2-6, the two antennas are situated at the same level, next to each other, so one is left (66) and the other right (60)).

Having a system of Nakamura '854, Lueker '105 and Tamagaki '924 and then given the well-established teaching of Talwar '505 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the image forming apparatus of Nakamura '854, Lueker '105 and Tamagaki '924 to include wherein the two antennas are respectively arranged on left and right sides of the rear surface of the main body of the image forming apparatus as taught by Talwar '505 because it would be desirable to have an interference cancellation system which will minimize noise degradation of a receiver (column 3, lines 38-42).

(7) regarding claim 16:

Nakamura '854, Lueker '105, Tamagaki '924 and Talwar '505 disclose all the subject matter as described above except wherein the predetermined distance is 1 cm.

However, common sense tell us that the predetermined distance could be any distance lower than the top of the automatic feeder, thus wherein the predetermined distance is 1 cm could reasonably be possible since a distance below the top of the automatic feeder could go from 0.1cm to the floor, thus an ordinary skill in the art would have chosen for example 1 cm.

Having a system of Nakamura '854, Lueker '105, Tamagaki '924 and Talwar '505 reference and then given the well-established teaching of common sense, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the image forming apparatus of Nakamura '854 to include wherein the predetermined distance is 1 cm as taught by common sense because the user would have a specific preference of distance that an antenna could not be installed under, thus allowing for user satisfaction and improved shape.

(8) regarding claims 17 and 18:

Nakamura '854, Lueker '105, Tamagaki '924 and Talwar '505 disclose all the subject matter as described above except wherein the uppermost part of the antenna is provided at a position between the uppermost part of the reversing automatic document feeder and a position that is lower by the predetermined distance than the uppermost part of the reversing automatic document feeder. Instead, Nakamura '854 shows that an antenna 111 is positioned at the back of the printer and above a position that is higher than a predetermined lower position (Drawing 2).

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to position the antenna of Nakamura

'854 between the top portion of the automatic feeder and a position that is lower by a predetermined distance because Applicant has not disclosed that having the uppermost part of the antenna is provided at a position between the uppermost part of the reversing automatic document feeder and a position that is lower by the predetermined distance than the uppermost part of the reversing automatic document feeder provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Nakamura '854 antenna, and applicant's invention, to perform equally well with either the position taught by Nakamura '854 or the claimed the uppermost part of the antenna is provided at a position between the uppermost part of the reversing automatic document feeder and a position that is lower by the predetermined distance than the uppermost part of the reversing automatic document feeder because both positions would perform the same function of receiving wireless transmissions from external sources.

Therefore, it would have been prima facie obvious to modify Nakamura '854 to obtain the invention as specified in claims 17 and 18 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Nakamura '854.

6. Claims 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura (JP 2002-086854) and Lueker (US 6,134,105) in view of Lynch et al. (US 6,069,587).

(1) regarding claim 4:

Nakamura '854 discloses all the subject matter as described above except wherein the two antennas each comprise a dual-band antenna.

However, Lueker '105 teaches the image forming apparatus having two antennas (21 in Fig. 1 and column 3, line 65 through column 4, line 1, where the printer has three antennas attached (two included) for data communication).

Having a system of Nakamura '854 reference and then given the well-established teaching of Lueker '105 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the image forming apparatus of Nakamura '854 to include the image forming apparatus having two antennas as taught by Lueker '105 because it would be desirable to have available a single, easily transported command unit which provides a fully functional, easily deployed and immediately operable communications and information transfer capability to users in remote locations. This command center would replicate and provide the functionality of a home agency information and computing system to a user at a remote site (column 1, lines 57-63).

Nakamura '854 and Lueker '105 disclose all the subject matter as described above except wherein the two antennas each comprise a dual-band antenna.

However, Lynch '587 teaches wherein the two antennas each comprise a dual-band antenna (10 in Fig. 1, column 3, lines 41-56).

Therefore it would be obvious to one of ordinary skill in the art at the time the invention was made wherein the two antennas each comprise a dual-band antenna as taught by Lynch '587 in the system of Nakamura '854 and Lueker '105. With this, when

the MEM switches are open, electrical isolation is established between the antenna segments, thereby allowing the antenna to operate in one frequency range without interference from the other frequency ranges. Accordingly, the MEM switches couple additional segments to the antenna, thereby allowing the antenna to operate in different frequency ranges (column 2, lines 22-28).

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **LENNIN R. RODRIGUEZ** whose telephone number is

(571)270-1678. The examiner can normally be reached on Monday - Thursday 7:30am - 6:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Zimmerman can be reached on (571) 272-7653. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lennin R Rodriguez/
Examiner, Art Unit 2625

/Mark K Zimmerman/
Supervisory Patent Examiner, Art Unit 2625